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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,498	09/02/2003	Randolf Von Oepen	31698-02080	2721
71/040 7590 04/28/2008 LUCÉ, FORWARD, HAMILTON & SCRIPPS 11988 EL CAMINO REAL, SUITE 200 SAN DIEGO, CA 92130				
EXAMINER PELLEGRINO, BRIAN E				
ART UNIT 3738		PAPER NUMBER		
MAIL DATE 04/28/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/652,498

Applicant(s)

VON OEPEN, RANDOLF

Examiner

Brian E. Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,8,10,16,21 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,8,10,16,21,23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Newly submitted claims 25-29 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claims are directed to different categories, for example the original apparatus claims are directed to a stent catheter system and the new claims are directed to a specific use of a stent catheter system in a blood vessel to throttle blood. The product claims originally examined do not require the apparatus to be used in a blood vessel and could be used in a materially different procedure, such as placing in a urethra, bile duct or esophagus.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-29 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,8,10,21,23,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchuk et al. (EP 861638) in view of Tower (US 5695498). Pinchuk illustrates (Figs. 8-11) a stent **100** that is "essentially" tubular and is dimensioned and configured to extend over a balloon catheter that has first and second "essentially" tubular sections and a segment of reduced expandability between the first and second tubular sections. Since the Applicant has not set forth in the original disclosure any special definition for "essentially tubular" the Examiner is interpreting the limitation in this way: something that is in the form of a conduit having a hollow or cylindrical like cross-section is "essentially" tubular. Claims are to be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). See also *In re Morris*, Fed. Cir. 1997 127 F3d 1048, 1054,1055. As seen in Figs. 9,10, the stent is expanded with "essentially" tubular fixing sections and an "essentially" tubular portion coupled to the fixing portions by tapering portions of predetermined lengths and angles and the tubular portion centrally located is radially spaced from the interior of the vessel wall. Pinchuk does disclose the stent has a graft (which is well known in the art to be liquid impermeable), col. 7, line 49. However, Pinchuk et al. does not explicitly disclose the particulars of the balloon catheter to deploy the stent graft, such as the balloon being selectively stiffened with the central section of reduced expandability. Tower teaches that a balloon catheter is constructed with a balloon having two "essentially" tubular sections expandable to engage the interior of a vessel wall and an essentially tubular section or reduced expandability between the two expandable sections, col. 3, lines 30-34. It would have been obvious to one of ordinary skill in the art to use a balloon

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catheter having a reduced expandability section as taught by Tower and use with the stent of Pinchuk et al. since the central section is not required to be expanded in treating the aneurysm.

Regarding claims 2,3,8,21 Pinchuk et al. disclose graft material is a "foil" of body-tolerated material, such as the polymer PTFE, col. 1, lines 48-50.

With respect to claims 10,23,24 Pinchuk also discloses that stiffening the midsection or segments of the apparatus is accomplished by placing rings about the surface of the stent and can be accomplished in a secondary process such as bonding, col. 7, lines 10-16,21-24.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchuk et al. in view of Tower as applied to claim 1 above, and further in view of Crocker et al. (5843116). Pinchuk in view of Tower is explained supra. However, Pinchuk as modified by Tower fail to disclose the stiffening elements are within the balloon segments in the reduced diameter section. Crocker et al. show (Fig. 3) that stiffening material is integrated into balloons to limit the expansion of the balloon in certain areas, col. 5, lines 29-49. It would have been obvious to one of ordinary skill in the art to use the teaching of Crocker et al. that stiffening material can be incorporated into balloons and place the stiffening elements of Pinchuk et al. within the balloon of Tower such that the elements are non-obtrusive and do not become unattached since Pinchuk taught separate elements. It would be an obvious expedient to eliminate the risk of stiffening elements from detaching during use of the apparatus by integrating them in the balloon.

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on M- F (9am-5:30pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC 3700
/Brian E Pellegrino/
Primary Examiner, Art Unit 3738